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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,016	11/16/2001	Kirk Kobmann	OB008DH-1	2966

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EXAMINER

PICKARD, ALISON K

ART UNIT	PAPER NUMBER
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3676

DATE MAILED: 01/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/991,016

Applicant(s)

KOBMANN ET AL.

Examiner

Alison K. Pickard

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 May 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 01 October 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. The corrected or substitute drawings were received on 10-1-02. These drawings are approved.
2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the seal that contacts a floor pan must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 12-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12 is unclear. How can “at least one compressible retaining feature” engage “a plurality of openings?”

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 2 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Walser.

Walser discloses an automotive floor pan extension comprising an injection-molded component 36 that contacts a floor pan 20 and an adjacent auto component 28 (sheet metal). The component has an integrally molded locking feature 40 and is contacted by a heat expandable sealant 42.

7. Claims 1, 3, and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Takabatake (5,642,914).

Takabatake discloses a sealing device comprising a non-symmetrical tub 31 having at least one fastening/locking feature 36 (weldable metal). Heat activated sealant 21 contacts the tub. The tub can be injection-molded (see col. 7, lines 58-60). The seal and sealant contacts at least three, metallic, automotive members 1, 2, and 3 (Fig. 2).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 4, 5, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Danico.

Danico discloses a sealing device comprising a tub-shaped component 50 having at least one integral fastening feature (e.g. 42) and at least one heat expandable material C. Danico discloses that the tub can be a variety of shapes (col. 3, lines 14-15). However, Danico does not

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disclose that the tub is non-symmetrical. This is considered a design choice. Applicants have not stated that a non-symmetrical tub solves any stated problem or is for any particular purpose and it appears the shape of Danico would perform equally as well. See *In re Dailey*, 149 USPQ 47 (CCPA 1966). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to make the tub non-symmetrical as a matter of choice in design.

Regarding claim 8, Danico discloses the component A can be formed of sheet metal or any other rigid material. Danico does not disclose that the rigid material is polyethylene terephthalate. Making the component from polyethylene terephthalate (a known rigid material) is considered a design choice. It is not considered inventive to select a known material based on its suitability for its intended use. See *In re Leshin*, 125 USPQ 416 (CCPA 1960). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to make the component/tub from polyethylene terephthalate as a matter of choice in design.

10. Claims 2, 3, 6, 7, 9-12, 14-16, and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamuro (5,829,824) in view of Larsen (6,419,305).

Yamamuro discloses three adjacent metallic automotive members 17 (or 15), 4, and 14 that form a cavity (see Fig. 2). The members comprise a floor pan 14, wheelhouse 4, and rail or sheet metal 15. Yamamuro does not disclose a cavity seal/pan extension or heat expandable sealant. Larsen teaches the use of a cavity seal between adjacent automotive members (col. 4, lines 1-16). The seal provides structural reinforcement and damping characteristics (i.e. for noise, dust, etc.). Larsen teaches that the cavity sealer is an injection-molded component shaped to fit within the cavity formed by the automotive members. The sealer 14 is secured in place

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within the cavity by integral locking tabs (see Fig. 4) and then is sealingly secured to the members by a heat-activated sealant 16. The sealer 14 comprises a fiber-reinforced thermoset (see col. 9, line 54). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the body structure disclosed in Yamamuro by reinforcing the cavity formed by the three members with the cavity sealer taught by Larsen to reinforce the structure and offer damping characteristics against force, noise, etc.

Regarding claim 10 (and 16), Larsen discloses the component can be made from an injection-molded polymer. However, Larsen does not disclose that the component is formed from polypropylene. Making the component from polypropylene (a known rigid polymer) is considered a design choice. It is not considered inventive to select a known material based on its suitability for its intended use. See *In re Leshin*, 125 USPQ 416 (CCPA 1960). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to make the component from polypropylene as a matter of choice in design.

11. Claims 12-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamuro in view of Takabatake in view of Larsen.

Yamamuro discloses at least two (three) adjacent metallic automotive members 17 (or 15), 4, and 14 that form a cavity (see Fig. 2). The members comprise a floor pan 14, wheelhouse 4, and rail or sheet metal 15. Yamamuro does not disclose a cavity seal/pan extension or heat expandable sealant. Takabatake teaches a cavity seal comprising a member 31 having a heat expandable sealant 21. The member is non-symmetrical, has a cavity, and an opening (see between walls 83 in Fig. 6). The member includes a weldable insert 36. Takabatake teaches that the cavity seal is placed in a cavity formed by automotive members and offers damping

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power and sound insulation. Takabatake does not disclose that the material of the member 31 is a thermoplastic or that it comprises a compressible locking tab. Larsen teaches a cavity sealer that is held in place within a cavity by fasteners (seen in Fig. 4). Larsen also teaches that cavity seal has a member that can be made from a thermoplastic (nylon) material or metal. Thermoplastics can be injection-molded for easy manufacture. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Yamamuro in view of Takabatake and further in view of Larsen to provide a seal with a easily manufactured member that can be effectively mounted and retained within a cavity formed by adjacent auto members to offer damping power and sound insulation.

Regarding claims 16 and 17, Neither Larsen or Yamamuro disclose the sealant is ethyl vinyl acetate or that the thermoplastic is one of polyester, polypropylene or polyethylene terephthalate. Making the items from these materials is considered a design choice. It is not considered inventive to select a known material based on its suitability for its intended use. See *In re Leshin*, 125 USPQ 416 (CCPA 1960). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to make the sealant from ethyl vinyl acetate and to select the thermoplastic from one of polyester, polypropylene or polyethylene terephthalate as a matter of choice in design.

Response to Arguments

12. Applicant's arguments filed 10-1-02 have been fully considered but they are not persuasive.

Regarding claims 2 and 6, Walser discloses a floor pan and at least one member such as sheet metal. The extension contacts both.

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Regarding claims 1, 4, 5, and 8, Damico discloses a tub with a fastening feature and heat expandable material. These claims do not recite any other structure other than the device (i.e. the adjacent metal car parts). The examiner maintains that it would be a design choice to modify the shape for an irregular opening.

Regarding the "material selection" design choice rejections made against claim 8 and others, it has been held that it is not considered inventive to select a known material based on its suitability for its intended use. See *In re Leshin*, 125 USPQ 416 (CCPA 1960). Thermoplastics such as polyester, polypropylene, and polyethylene terephthalate are known in the art for their rigidity, durability, and moldability.

As stated above, Larsen and Takabatake disclose cavity sealers used to seal between automotive parts. Yamamuro discloses that a cavity formed by a floor pan and other automotive members is known.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited prior art discloses various cavities formed by car parts and cavity sealers.

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period


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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alison K. Pickard whose telephone number is 703-305-0882. The examiner can normally be reached on M-F (9-6:30), with alternate Friday's off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Knight can be reached on 703-308-3179. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-8729327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-1113.


Anthony Knight
SPE
Art Unit 3676

AP
December 27, 2002